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EXAMINER

LOFTUS, ANNE

ART UNIT

PAPER NUMBER

3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/032,153	Applicant(s) LANGNER ET AL.	
	Examiner ANN LOFTUS	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,22-38 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-20, 22-38 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to an amendment filed on 1/26/09. The application was filed on 12/21/01. Claims 1, 3-20, 22-38 and 42-47 are pending. The declaration, title, abstract, drawings and Brief Description of Figures are satisfactory.
2. The examiner notes that US 2004/0010435 (10/371,885) shares inventor LaBahn and assignee Dun & Bradstreet with the instant application. It was filed 2/21/2003 with a provisional filed 2/22/2002. Its claims as of 2/13/09 do not recite menus or folders, and its claimed invention is interpreted as focused on the report features as opposed to the interface features.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission has been entered.

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The applicant argues that the amended claims are not covered by the references previously cited. See the revised rejections that address the changes.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-20, 22-38, and 42-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 1, the Bilski decision establishes the following test for claimed processes under 35 USC 101. The process passes if :

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental

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principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Bilski further says that the particular machine or apparatus or transformation must be central to the purpose of the claimed process, and not mere extra-solution activity such as gathering data or recording results. As far as the transformation, Bilski also says on page 28 “Purported transformations of manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.” The transformation of data unrelated to the physical world is thus not sufficient.

While there are hints of a computer context in claims 1 and 20, a particular machine is not positively recited, thus the link of a central core method step to a particular machine becomes doubtful. Claims 4 and 23 recite a user device for presenting the menu. The recited purpose is providing business information to the user, thus the user device presenting the menu is interpreted as gathering data such as user choices, and not central to the purpose of providing business information. Claims 6 and 33 introduce a business device, but still concern presenting menus instead of providing

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business information. Claim 15 hints at the computer but does not positively recite a particular device. The dependent claims fail to remedy the problem.

Claims 1, 3-20, 22-38, 44, and 45 recite methods that are not adequately tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing; therefore, they are non-statutory under § 101.

Claim 42 recites a computer comprising modules. Claim 43 recites a memory media comprised of modules. Modules are not defined in the specification, and could be interpreted as entirely software. Software per se is non-statutory, unless it is computer-executable instructions embedded in a computer readable medium. This computer and media as claimed have no physical structure, and are thus not statutory. The dependent claims do not remedy the problem. Thus claims 42, 43, 46 and 47 are rejected as non-statutory.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 3-20, 22-38, and 42-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The written description (including the drawings and original claims and incorporated references) is required to support possession of the claimed scope of the invention. The claim(s) contains subject matter which was not described in the

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specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. If the limitation is not explicit, the applicant has the burden of showing that a person of ordinary skill in the art "would have understood, at the time the patent application was filed, that the description requires the limitation." Hyatt, 47USPQ 2d @1131. An arbitrary narrowing of the scope of the claim is not compliant unless the description explicitly supports or would require the narrowing limitation.

Claims 1, 20, 42 and 43 recite a user maintaining a folder. A user maintaining a folder is not described in the specification in such a way as to indicate possession of the claimed feature. A tracking folder is recited, but there is no mention of what maintenance it needs, or how the user could maintain it. Dependent claims inherit the problem.

Claims 1, 20, 42 and 43 recite a centralized service provider. A centralized service provider is not described in the specification in such a way as to indicate possession of the claimed feature.

Claims 1, 20, 42 and 43 recite an integrated interface. The only interface in the specification is a database interface unit. The only integration in the specification refers to parts of the method or system being integrated into a user device application program. The figures depict menus which are not referred to as integrated in any way. An integrated interface is not described in such a way as to indicate possession of the claimed feature.

Claims 1, 20, 42 and 43 recite storing the delivered data in a folder. Storing data in a folder is not described in the specification in such a way as to indicate possession of the claimed feature.

9. Claims 42 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The test for enablement is that the written description is required to enable a person of ordinary skill in the art to make and use all embodiments within the scope of the claim.

As above, claims 42 and 43 are not limited to any particular physical structure since they are comprised of modules. Thus any structure known or unknown would be within the scope. The unknown structures are not enabled by the specification, thus a system without structure is not enabled. Claims 46 and 47 fail to remedy the problem.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 3-20, 22-38, and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 11, 20, 28, 42 and 43 recite **permitting** a user. Claims 13 and 30 recite **providing** a user with the capability. These terms are problematic because they do not define the metes and bounds of the supporting action. Any supportive action that

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contributes in any way to the limitation such as supplying electricity or supplying an operating system or even teaching can be seen as permitting or providing with a capability. Some supportive actions are strongly related to the invention, and some less so. That leaves unclear which supportive actions are considered relevant, which means the metes and bounds of the claim are unclear.

A further problem is that permitting a user to do something does not positively recite the action as occurring, so that it cannot serve as an antecedent. Steps a-d are reduced to intent, which does not patentably distinguish the invention from the art, because the manipulative steps are not specified to actually occur; rather, only permission is given. No selection act is recited, which means there is no antecedent basis for the said **selected** plurality of business services.

Claims 1, 20, 42 and 43 further recite **maintaining a folder, a list that includes said folder, and storing data in a folder**. The term folder is an abstract organizational idea. The interfaces shown consist of hyperlinks that allow navigation to data. Is the data physically stored in a foldable folder? Is it all in the same database table? Is the database table stored on a single disk? What does it mean to maintain the folder? Does that mean updating the “contents” or does it mean not deleting the name of the folder, or the link to the “contents”? Does the list include the name of the folder, or a link to the folder, or include the folder and its contents? The terms are impermissibly vague.

Claims 1, 20, 42 and 43 recite providing business information in the preamble, and then delivering data in the body. What is the relationship of the **data** and the **information**?

Claims 9 and 26 recite presenting **directly** via a browser. This is ambiguous because there are normally several devices between the user device and the web page servers. If the page passes through a firewall, is it still sent directly? If it takes extra router hops to reach its destination, is it still sent directly? If it is received and cached before presentation, is it still sent directly? The word directly often means more directly than a particular unspecified alternative, and that leaves the metes and bounds unclear.

The remaining claims listed are rejected as inheriting the problems cited.

While it is difficult to interpret the metes and bounds of the claims, especially for the reasons explained in the rejections under § 112, 2nd paragraph, the Examiner herein applies an art rejection based on her best interpretation of the claims in the interest of advancing prosecution.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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13. Claims 1, 3, 4, 6, 8-10, 15-17, 20, 22, 23, 25-27, 32, 33, 35, 36, 42 and 43 are rejected under 35 U.S.C. 102(a and e) as being anticipated by US 20010032170 filed 2/1/01 (provisional 8/24/99, published 10/18/01) by Sheth.

As to claims 1 and 20, the manipulative steps recited are: presenting one or more menus, processing an order, and delivering data. The contents of the menu do not have a recited functional relationship with the manipulative steps. As to claims 42 and 43, the structure recited is related to the same manipulative steps. The contents of the menu do not affect the manipulative steps that follow, because there is no act of selecting from the menu. Language that is not functionally interrelated with the useful acts, structure or properties of the claimed invention will not serve as a limitation, thus the menu contents do not patentably distinguish the claimed invention from the references cited.. See *In Re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex Parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims. Regardless, the contents of the menu are addressed below, in the interest of compact prosecution.

Note that Sheth discloses a user as an enterprise, such that both Sheth's private marketplace owner and Sheth's user are considered included in the scope of the claimed user.

Sheth teaches a method of providing business information to a user comprising: Presenting to said user through an integrated interface one or more menus, (paragraphs 100-101 page 6) that permit a user to maintain a folder that holds information concerning a business, access a list that includes said folder, and select

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said folder from said list to identify said business as a target business in Figs 7, 8 and 11, and paragraphs 83-85 page 4, as well as paragraph 109 page 7. “To identify said business as a target business” is intent, and will not serve to patentably distinguish the invention from the reference. Sheth teaches processing by said centralized service provider, an order for said selected plurality of business services concerning said target business in Fig 16, and paragraph 72 page 3. Sheth teaches delivering data from said selected plurality of business services concerning said target business through said integrated interface to said user and storing data in said folder in paragraph 125 page 9.

Further as to claim 20, Sheth teaches preparing a report on said target business based upon said selected plurality of business services, in paragraphs 98-99 page 6.

Further as to claims 42, and 43, Sheth teaches modules in figure 19, i.e. a database module, an application module and a web server module. See also paragraph 69 page 3.

As to claims 3 and 22, Sheth teaches presenting and delivering online in paragraph 13 page 1 and paragraph 125 page 9.

As to claims 4 and 23, Sheth teaches presenting is at least partially implemented in an application in a user device operated by said user in paragraph 77 page 4.

As to claims 6 and 33, Sheth teaches presenting is at least partially implemented in a business device that presents at least one of said one or more of said menus to a user device operated by said user in Fig 19 (where a web server is a business device.) Sheth teaches an application hosting model in paragraph 77 page 4.

As to claims 8 and 25, Sheth teaches one or more menus presented on one or more web pages in Fig 4.

As to claims 9 and 26, Sheth teaches presenting one or more web pages to said user directly via a browser running on a user device operated by said user in paragraph 77 page 4.

As to claims 10 and 27, Sheth teaches at least two business services presented on a single menu in Fig 11.

As to claims 15 and 32, Sheth teaches delivering data by posting to a designated area of said interface in paragraph 125 page 9.

As to claims 16 and 35, Sheth teaches communicating an alert notice concerning said target business to said user in paragraph 123 page 8.

As to claims 17 and 36, Sheth teaches an alert notice (as part of the transaction history) filed in a tracking folder for said target business, and wherein said tracking folder is accessible via said one or more menus in paragraphs 108 and 109, page 7.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 3, 4, 6, 8-10, 15-17, 20, 22, 23, 25-27, 32, 33, 35, 36, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth.

Sheth teaches the claimed features as listed above.

16. Claims 13, 18, 19, 30, 37, 38, and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth as applied above, in view of US 20020072927 filed 11/14/01 (provisional 11/14/00) by Phelan et al.

As to claims 13 and 30, Sheth does not teach risk evaluation reports. Phelan teaches risk evaluation reports (credit reports) in page 6 paragraph 60. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Sheth to add risk evaluation reports to avoid unpaid bills.

As to claims 18 and 37, Sheth teaches presenting to said user records of at least one of said user's customers in Fig 8. Sheth does not teach presenting to said user a payment performance record of at least one of said user's customers, nor communicating said payment performance record to a business service providing system. Phelan teaches in paragraphs 58-61 page 6 presenting to said user a payment performance record of at least one of said user's customers. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Sheth to add payment performance records in order to help a business analyze credit options for its customers. Phelan teaches communicating said payment performance record to a business service providing system in paragraph 49 page 5. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Sheth combination to add communicating a payment performance record to a

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business service providing system in order to collect the information to sell to other users.

As to claims 19 and 38, Sheth does not teach payment performance records. In paragraph 41 page 3, Phelan describes the user putting appropriate records into a temp folder for transfer. This suggests that the user selected appropriate records. Thus Phelan suggests the user selects the payment performance records that are communicated to said business service providing system. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Sheth to add the user selects the payment performance records that are communicated to said business service providing system in order to allow the user to protect the privacy of certain customers.

As to claims 44-47, Sheth teaches a business service as a marketing service and a supplier service in Figs 44a-d, and an alert service in paragraph 123 on page 8. Sheth does not specifically teach a credit checking service or a collection service. Phelan teaches a credit checking service in the abstract. The background of the invention in the specification teaches that collections services are old and well-known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Sheth to add business services including credit checking and collections in order to integrate a company's relationships in a single application.

17. Claims 5, 7, 11, 12, 24, 28, 29 and 34 are rejected under 35 U.S.C. 103 as being unpatentable over Sheth as applied above, in view of Official Notice.

As to claims 5, 7, 24 and 34, Sheth discloses a menu displayed on a device, but does not specifically disclose menus cached in a device. Official Notice, [now admitted prior art] as taken in the first action, is repeated: that web pages were commonly displayed in browsers, which commonly cache pages on a user device. It would have been obvious that the menus of Sheth could be cached in a user device in order to re-display the page quickly, without having to fetch the entire page over a network a second time. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Sheth to add menus cached in a user or business device in order to hasten presentation of the menu.

As to claims 11 and 28, Sheth teaches permitting a user to categorize said target business to a group including vendors in Fig 7. Sheth does not specifically teach allowing a user to categorize a target business by customer, supplier, partner, competitor, project or user's company. Official Notice, [now admitted prior art] as taken in the first action, is repeated: that customer, supplier, partner, competitor, project and user's company are common keywords to use for identifying a relationship between companies. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Sheth to add the listed categories in order to facilitate searches and increase organization.

As to claims 12 and 29, Sheth teaches permitting a user to categorize said target business to a group including vendors in Fig 7. Sheth teaches a menu with categories of sell to and buy from in Fig 44a. Sheth does not explicitly teach allowing a user to categorize a target business by: compete, get paid and locate. Official Notice [now

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admitted prior art] is taken that sell to, buy from, compete, get paid and locate are common keywords to use for identifying a relationship between companies. It would have been obvious to a person of ordinary skill in the art at the time of the invention to allow a user to use those keywords to categorize business data because then all businesses with a particular type of relationship would be tagged, and could be used together as input for mail merges and such.

18. Claims 14 and 31 are rejected under 35 U.S.C. 103 as being unpatentable over Sheth in view of Phelan, as applied above, in view of Official Notice.

As to claims 14 and 31, Sheth teaches comments in the interface that track general reputation. Sheth does not teach presenting credit risk with a risk indicator that designates low/moderate/high risk in a color coded manner. Official Notice [now admitted prior art], as taken in the first action, is repeated: that meter icons are well recognized graphic indicators of risk. Meter icons resemble temperature or pressure gauges, where a rotating indicator needle can rise from a low safer range, often a green wedge to the left, through a middle zone, to a more risky red wedge on the right. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use a meter icon on a report to designate either a low risk, a moderate risk or a high risk in a color coded manner in order to have an icon that would convey meaning quickly to a broad range of people.

Conclusion

19. While portions of interest have been indicated, all references should be considered for the entirety of their teachings.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL
/Susanna M. Diaz/

Primary Examiner, Art Unit 3692